

a wiring panel adapted to install within said box and to electrically connect to said power cable;

a keyed panel fixture located on said wiring panel;

a module adapted to electrically connect to said wiring panel so as to transfer power from said power cable; and

a keyed module fixture located on said module,

said keyed panel fixture and said keyed module configured to engage so as to removably attach said module to said wiring panel only in a proper orientation.

35. The wiring assembly of Claim 44 further comprising a ground bar configured to engage a ground connector in said proper orientation.

### REMARKS

Applicant respectfully requests reconsideration of this application in light of the foregoing amendments and the following remarks. In the Office Action mailed January 19, 2001, Claims 1-11, 16-19, 24-29 and 32-35 were considered following an election made by Applicant in response to the Examiner's restriction requirement. The Examiner rejected Claims 1, 3, 4, 7-10, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 4,103,125 to Marrero; rejected Claims 32-35 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 4,165,443 to Figart et al.; rejected Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Marrero; rejected Claims 24-29 under 35 U.S.C. § 103(a) as being unpatentable over Figart; rejected Claims 2, 6, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Marrero in view of Figart; and rejected Claims 5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Marrero in view of US Patent No. 5,906,497 to Pham et al. By this Amendment, Claims 4, 6-9, 16 and 32 have been amended and Claims 36-45 have been added. Thus, Claims 1-11, 16-19, 24-29, 32-35 and 36-45 are currently pending.

#### Claims 1, 3, 4, 7-10, 16, 17 § 102(b) Rejections

The Examiner rejected apparatus Claims 1, 3, 4, 7-10, 16, 17 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 4,103,125 to Marrero ("Marrero"). Office Action (OA), ¶6. Applicant respectfully traverses the Examiner's rejection of these claims. FIGS. 4E, 7A, 8B from the present application are reproduced below to illustrate elements of Applicant's claims that patentably distinguish over Marrero.

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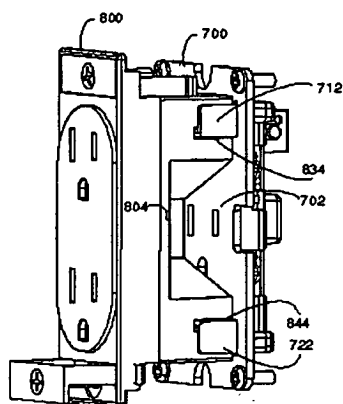


FIG. 4E

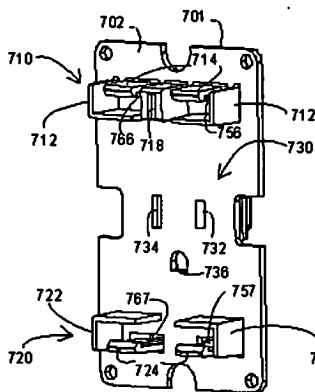


FIG. 7A

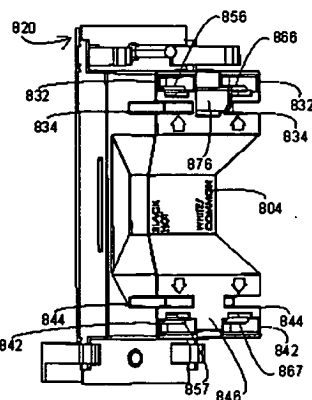


FIG. 8B

### Claim 1

Claim 1 recites in part:

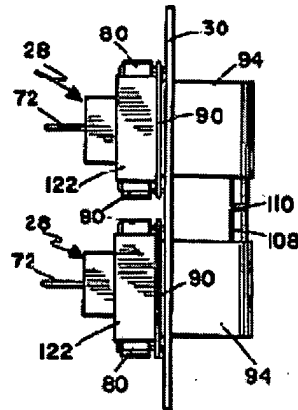
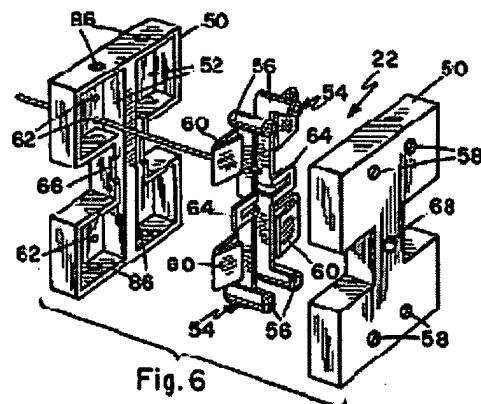
a generally planar wiring panel having a front side 702 and a back side, said front side having a panel fixture 712, 722 (FIG. 7A) extending perpendicularly from said front side and a shielded contact surface 756, 766, 757, 767 (FIG. 7A) within said fixture . . . ; and

an electrical module (FIG. 8B) comprising a front cover and a back cover 804 (FIG. 8B), said front cover providing a user accessible electrical function, said back cover having a module fixture 830, 840 (FIG. 8B) and a shielded spring contact 856, 866, 857, 867 (FIG. 8B) within said module fixture, said module fixture configured to engage said panel fixture so as to connect said spring contact with said contact surface; . . .

See Claims, p. 40, ll. 5-15.

FIGS. 6-7 from Marrero are reproduced below to illustrate that Claim 1 patentably distinguishes the electrical switch and outlet assembly of Marrero.

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In reference to FIG. 6, Marrero discloses a junction cartridge (22) having a pair of mating halves (50) that define internal cavities (52) that seat two junction elements (54). The junction elements provide side clips (60) that engage power wires and tunnel contacts (56) that are receptacles for module prongs (72) (FIG. 7). Marrero, c. 3, ll. 26-41.

In reference to FIG. 7, Marrero also discloses a module (28) having a pair of rearwardly projecting prongs (72) which are plugged into the tunnel contacts (56) behind the holes (58) in the front half (50). Marrero, c. 4, ll. 6-8.

Marrero does not disclose or enable a shielded spring contact within a module fixture or a module fixture configured to engage a panel fixture so as to connect the spring contact with the contact surface as claimed. The Examiner asserts that Marrero's junction elements (54) are a "panel fixture" and the tunnel contacts (56) are a "shielded contact surface." OA, ¶6, ll. 8-9. The Examiner further asserts that the Marrero prongs (72) are a "shielded spring contact" and that Marrero has a "module fixture" configured to engage these junction elements (54). OA, ¶6, ll. 12-13.

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable.*" MPEP §706(c)(2), emphasis added. Here, the Examiner did not designate the part disclosed in Marrero that was relied on as a "module fixture."

Regardless, because the Marrero junction elements (54) are completely enclosed with the halves (50) and are accessible only via the holes (58), the only part of the Marrero module (28) that can engage the junction elements (54) are the Marrero prongs (72). The Examiner cannot designate these prongs (72) as both a "shielded spring contact" that connects with the "shielded

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contact surface (56) and also a "module fixture" that engages the "panel fixture" (54), as claimed, because to do so would require the prongs (72) to be within the prongs (72), which does not make sense. Thus, Marrero has no module fixture that can be logically designated and, therefore, does not anticipate Claim 1.

In addition, the Marrero prongs (72) are not a "shielded spring contact." In particular, the prongs 72 are neither shielded nor spring contacts. The present specification states:

[T]he outlet module contacts 856, 857, 866, 867 are spring contacts each extending from busses . . . During installation, as the outlet module is pressed against the wiring panel the top and bottom module contacts press against corresponding [panel latches]. . . . When sufficient pressing force is applied, the spring contacts . . . flex until the contact points . . . connect with the contact surfaces of the panel contacts.

Spec. p. 24, ll. 6-17; *see also* FIG. 8B, above. Marrero fails to teach or enable that the module prongs (72) have any spring characteristics or that these prongs (72) flex in order to make contact with the junction elements (54). Indeed, as noted above, the Marrero prongs (72) merely plug straight into the tunnel contacts (56).

Marrero also fails to teach or enable any structure that shields the module prongs (72). The present specification also states:

[T]he back cover 804 has top recessed portions 891 within the top contact housings 832 that retain the top outlet contacts 856, 866. Similarly, the back cover 804 has bottom recessed portions 892 within the bottom contact housings 842 that retain the bottom outlet contacts 857, 867.

Spec. p. 22, ll. 19-22. Indeed, as seen in Marrero FIG. 7, shown above, the prongs (72) are exposed on all sides.

In summary, Applicant respectfully submits that Claim 1 is not anticipated by the Marrero patent and should be passed on to allowance. Further, Claims 2-6, which depend from Claim 1, are likewise allowable. Claims 3 and 4 further patentably distinguish over Marrero, as described below.

### **Claim 3**

FIG. 12 from the current application is reproduced below to illustrate elements of Applicant's Claim 3 that patentably distinguishes over Marrero.

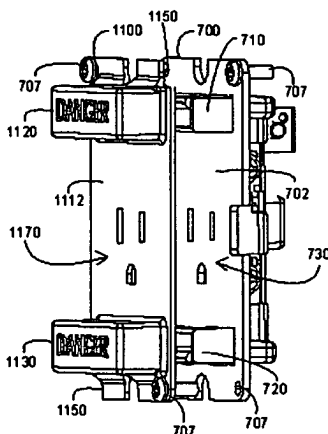


FIG. 12

Claim 3 recites the electrical wiring assembly of Claim 1 wherein said wiring panel has a socket 730 providing access to electrical power when power cabling is attached to said cable connector, said electrical wiring assembly further comprising a protective cover 1100 installable over said wiring panel front side 702 and having plug openings 1170 so as to allow plug access to said wiring panel socket 730.

The protective cover of the present invention solves several problems that are not addressed by Marrero. As stated in the specification, a conventional electrical box is susceptible to damage during wall panel installation:

During the makeup phase, installation of the wall panels can damage the work completed during the rough phase. One way in which damage occurs is router contact with exposed cables when drywallers create a hole to accommodate electrical box openings. Another form of damage occurs when drywall compound or paint fouls the exposed cables, insulation and labeling.

Spec. p. 2, ll. 15-19. According to the present invention: "A protective cover is provided that prevents fouling by drywall compound or other materials during the makeup phase." Spec. p. 4, ll. 2-3. This protective cover is installable over said wiring panel. Spec. p. 41, l. 1. In Marrero, the junction cartridge (22) is installed during the trim phase, when the face plate is attached. As such, the junction cartridge needs no protective cover, and, indeed, it has no protective cover.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in

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as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

MPEP §2131.

In rejecting Claim 3, the Examiner erroneously identifies the same element of Marrero as being distinctly claimed elements of the invention. In particular, in rejecting Claim 1, the Examiner designates the Marrero junction cartridge (22) as a "wiring panel" and a Marrero mating half (50) as a "front side" of the wiring panel having a "panel fixture" (54) and a "shielded contact surface" (56). OA, ¶ 6, l. 7-9. However, in rejecting Claim 3, which depends from Claim 1, the Examiner identifies a Marrero mating half 50 as a "protective cover" having "plug openings" (58), i.e. the holes (58) that provide access to the tunnel contacts (56). OA, p. 4, l. 3. Asserting that the Marrero mating half 50 is both a wiring panel front-side and a protective cover ignores these distinct elements set forth in Claim 3.

Further, the Examiner apparently ignores the functional limitation that the protective cover is installable over said wiring panel. There is ample precedent to establish that functional limitations are appropriate in claims and should be afforded patentable weight by the Examiner for determining anticipation. For example, in *RCA Corp. v. Applied Digital Data Systems, Inc.* 221 USPQ 385 (Fed Cir. 1984) the court stated:

The limitations which must be met by an anticipatory reference are those set forth in each statement of function. . . . Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept.

*Id.* @ 389, n. 5. Here, the Examiner's assertion that a Marrero mating half (50) is both a wiring panel front-side and a protective cover requires that the Marrero mating half (50) be installable over itself, which does not make sense. In summary, Applicant respectfully submits that Claim 3 is not anticipated by Marrero on this further basis and should be passed on to allowance.

#### **Claim 4**

Claim 4, as amended, recites:

The electrical wiring assembly of Claim 1 further comprising a face plate having a protruding tab, said module having a corresponding catch so that said face plate removably snaps onto said module front cover when said module is in said installed position.

Here, the Examiner identifies the Marrero face plate (30) and designates the Marrero face plate clip (76) as a protruding tab and the Marrero bent clip element (74) as a corresponding module catch. Marrero, however, does not teach or suggest that the face plate removably snaps onto the module front cover when the module is in the installed position as claimed. Indeed, a Marrero face plate (30) cannot be removed from a Marrero module (26), (28) when the module (26), (28) is in the installed position. Specifically, the Marrero modules install in the Marrero face plate, and then the combination of module and face plate is installed in the wiring box. This is necessary in Marrero because the modules do not have any separate mechanical support without the face plate. As described in Marrero:

a receptacle module 26 would be clipped into the top portion of the face plate 30  
and a switch module 28 would be clipped in the bottom portion. The face plate together with modules would then be inserted into the previously assembled wiring box . . .

Marrero, c. 4, ll. 18-25, emphasis added. Therefore, Marrero cannot anticipate the present invention according to amended Claim 4.

#### **Claim 7**

FIG. 14A from the current application is reproduced below to illustrate further elements of Applicant's claims that patentably distinguish over Marrero.

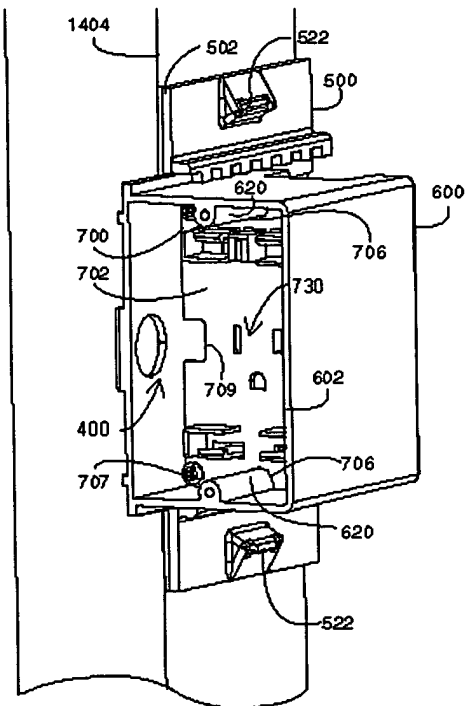


FIG. 14A

Claim 7, as amended, recites in part

a wiring panel 700 comprising a generally planar board, said wiring panel fastened within said electrical box 600 so as to partition the interior of said box into a user accessible module compartment 400 proximate said front face and a user inaccessible wiring compartment proximate said back face,

said wiring panel having a fixture 710, 720 (FIG. 7A, above) within said module compartment and a cable connector within said wiring compartment . . .

The wiring panel of the present invention focuses, in part, on a safety issue not addressed by Marrero. As described in the specification, the partitioning of the electrical box interior advantageously allows access only to the module compartment 400, which is physically separated from the exposed wiring of the power cables within the wiring compartment (not visible). There is no access to the building electrical wiring without physical removal of the wiring panel 700, preserving the integrity of the electrical wiring from third-party tampering and protecting third-parties from the shock hazard of exposed high voltage conductors. Access to the module compartment, which has shielded, snap-in contacts, allows easy and comparatively safe installation or replacement of modules by unskilled personnel. Spec., pp. 37-38.

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In rejecting Claim 7, the Examiner designated the Marrero mounting bracket (20) and junction cartridge clip (24) as an "electrical box" and the Marrero junction cartridge (22) (Fig. 6) as a "wiring panel." OA, p. 4, ll. 6-8. The Examiner also designated the Marrero junction elements (54) as a "fixture" and the Marrero side clips (60) as "cable connectors." *Id.* The Marrero junction cartridge (22) is apparently designed for pre-fabrication and assembly convenience rather than safety. "As the unit is received by the on-site electrician, the junction cartridge is inserted into the junction cartridge clip . . . The junction cartridge makes all the electrical connections . . . Thus, at the construction site the workman has only two component parts to connect." Marrero, c. 2, ll. 40-56. Hence, it is not surprising that the junction cartridge (22) has neither the claimed structure nor the claimed function of the wiring panel 700 of the present invention.

First, the Marrero junction cartridge (22) does not comprise a generally planar board as claimed. Further, the Examiner does not designate any particular part of the Marrero junction cartridge (22) relied upon as a generally planar board as required. *See* MPEP §706(c)(2) ("the particular part relied on must be designated as nearly as practicable"). Thus, the Office Action does not set forth a prima facie case of anticipation with respect to Claim 7 on this basis alone.

Second, the Marrero junction cartridge (22) does not partition the mounting bracket (20) and junction cartridge clip (24) into a user accessible module compartment and a user inaccessible wiring compartment as claimed. The Examiner apparently ignores this functional limitation contrary to well established case law, e.g. *RCA Corp. v. Applied Digital Data Systems, Inc.* 221 USPQ 385, 389, n. 5 (Fed Cir. 1984), cited above. The Examiner does not describe how the Marrero junction cartridge functions to partition the mounting bracket (20) and junction cartridge clip (24) and does not designate the resulting user accessible module compartment and user inaccessible wiring compartment that results. *See* MPEP §706(c)(2), cited above. Thus, the Office Action does not set forth a prima facie case of anticipation with respect to Claim 7 on this basis also, and, without more, the Applicant is entitled to allowance of this claim. Claims 8-10, which depend from Claim 7, are also allowable as such. Dependent Claim 8 is further allowable on the following bases.

#### **Claim 8**

Claim 8, as amended, recites the electrical wiring assembly of Claim 7 wherein said fixture has a first contact and said module has a corresponding second contact, one of said first

and second contacts having a latch and an associated contact surface and the other one of said first and second contacts having a spring contact.

In rejecting Claim 8, the Examiner designates the Marrero junction elements (54) as a "fixture" and the Marrero tunnel contacts (56) as a "first contact." The Examiner also designates the Marrero module prongs (72) as a "second contact." The Examiner does not, however, designate the claimed latch, the claimed associated contact surface or the claimed spring contact as required. *See* MPEP §706(c)(2) ("the particular part relied on must be designated as nearly as practicable"). Thus, the Office Action does not state a prima facie case of anticipation with respect to Claim 8, and, without more, the Applicant is entitled to allowance of this claim. Claim 9, which depends from Claim 8, is also allowable as such.

#### **Claim 16**

Claim 16 as amended recites in part:

- a contact surface electrically connected to said cable connector;
- a panel fixture located on said wiring panel front face and housing said contact surface;
- a prong connector electrically connected to said cable connector; and
- a socket located on said wiring panel front face and housing said prong connector . . .

In rejecting Claim 16, the Examiner designates the Marrero tunnel contacts (56) as "a contact surface" and a side clips (60) as "a cable connector." Marrero, however, does not disclose both a panel fixture housing a contact surface and a socket housing a prong connector. As such, the Applicant asserts that Claim 16, as amended, is in condition for allowance.

#### **Claim 17**

Dependent Claim 17 is further allowable over Marrero for reasons similar to those cited above with respect to Claim 3. Specifically, Claim 17 recites, in part, "a protective cover mounted over said wiring panel front side." The Examiner's designates a Marrero mating half (50) as both a "wiring panel front-side" (with respect to Claim 16) and a "protective cover." OA, p. 3, l. 15; p. 4, l. 3. The Examiner ignores the structural limitation that the protective cover is mounted over the wiring panel front side, because the Examiner designated elements would then require that the Marrero mating half (50) be mounted over itself, which does not make sense.

#### **Claims 32-35 § 102(b) Rejections**

The Examiner rejected apparatus claims 32-35 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 4,165,433 to Figart et al. ("Figart"). OA, ¶7. pp. 4-5. Claims 32-

35 invoke 35 U.S.C. § 112, ¶6. In order to make a prima facie case of equivalence the Examiner must first find "that a prior art element performs the function specified in the claim." MPEP § 2183. Unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. § 112, ¶6. MPEP § 2184, citing *Pennwalt Corp. v. Durand-Wayland, Inc.*, emphasis added. Further, an "applicant may choose to amend the claim by further limiting the function so that there is no longer identity of function with that taught by the prior art element." MPEP § 2184.

#### **Claim 32**

Claim 32, as amended, recites, in part, a snap-in means for removably attaching and electrically connecting said module means to said wiring panel means with tactile feedback. The Examiner designates Figart openings (25) and spring contacts (64c) as "snap-in means." Figart does not teach or enable that the function of the openings (25) and spring contacts (64c) includes tactile feedback. The snap-in means, therefore, do not encompass the Figart openings (25) and spring contacts (64c) and Claim 32 is patentably distinguished over Figart on this basis. Claims 33-35 depend from Claim 32 and, therefore, are also patentably distinguished over Figart. Dependent Claims 34-35 further patentably distinguish over Figart as described below.

#### **Claim 34**

Claim 34 recites the electrical wiring assembly of Claim 32 further comprising a protective cover means for shielding said wiring panel during the makeup phase of building construction. The Examiner designates the Figart bus plate (50) as a "wiring panel" and the Figart rear panel (26) as "a protective cover means." Figart, however, does not teach or enable that the function of rear panel (26) is to shield the bus plate (50) during the makeup phase of building construction. Indeed, the Figart rear panel (26) is positioned on the wrong side of the electrical box to perform this function. (See the discussion with respect to Claim 3 and the associated FIG. 12, above). For this additional reason, Claim 34 is allowable in view of Figart.

#### **Claim 35**

Claim 35 recites the electrical wiring assembly of Claim 32 further comprising a face plate means for trimming said module when installed within said electrical box. The Examiner does not designate the particular part of Figart relied on for a "face plate means" as required. MPEP 706(c)(2). As such, the Office Action does not state a prima facie case of anticipation. If the examination at the initial stage does not produce a prima facie case of unpatentability, then

without more, the applicant is entitled to grant of the patent. *In re Oetiker* (Fed. Cir. 1992) 24 USPQ2d 1443, 1444. Applicant asserts that Claim 35 is allowable on this additional basis.

#### **Claim 19 § 103(a) Rejection**

Claim 19 recites the electrical wiring assembly of Claim 16 wherein said recess is at least about 1.25 inches so as to avoid damage to said wiring panel during wall panel installation. Claims, p. 44, ll. 20-22. As an initial matter, Claim 19 depends from Claim 16, which Applicant asserts is in condition for allowance. As such Claim 19 is also in condition for allowance.

The Examiner rejected Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Marrero, citing *In re Aller* (where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art). *In re Aller*, however, is inapplicable because the claimed range is not a result-effective variable. As stated in the MPEP:

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.

MPEP §2144.05, citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Specifically, it is the Examiner's burden to show that Marrero recognizes that the recess of the electrical box internal mounting post from the electrical box front face is a variable that achieves a recognized result. The Examiner designates the "vertical projection" of the Marrero side track forming member (46) as a "internal mounting post." OA, p. 3, ll. 13-14. Marrero is entirely silent with regard to the location of this member from the electrical box front face (which the Examiner has not designated with particularity). Much less does Marrero teach that this location achieves a recognized result. Indeed, the location of the vertical projection of the Marrero side track forming member (46) seems to be entirely dependent on the thickness of the Marrero junction cartridge (22). Marrero, c. 3, ll. 18-20. Thus, the Office Action has failed to state a prima facie case of obviousness with respect to Claim 19, and, without more, Claim 19 is allowable. *In re Oetiker*, cited above.

## Claim 24-29 § 103(a) Rejections

### Claim 24

Claim 24 recites an electrical box assembly comprising:

a box mount attachable to a wall stud in accordance with a stud alignment guide of said box mount;

a plurality of catches located along said box mount;

an electrical box having a front face, said box slidably attached to said box mount;

a latch portion of said box configured to releasably engage any of said catches,

said box having a plurality of fixed positions corresponding to said catches, each of said positions placing said front face at a specific distance from said alignment guide so that said electrical box can be adjusted for various wall panel thicknesses.

Claims, pp. 45-46.

The Examiner cites Figart as disclosing all of the elements of Claim 24 except that the Figart locking indentations (33), which the Examiner designates as "catches," are located on the Figart box (10) rather than on Figart mounting bracket (37), which the Examiner designates as a "box mount." OA, p. 6, ll. 1-9. The Examiner then cites *In re Japikse*, 86 USPQ 70 for the proposition that there "would be no invention in shifting location of parts to a different position since the operation of the device would not be thereby modified." OA, p. 6, ll. 10-11. The MPEP, however, states that this bare assertion is insufficient to reject Claim 24:

However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

MPEP §2144.04, emphasis added.

Thus, in order to reject Claim 24, the Examiner has the burden of showing that Figart provides a motivation or reason to locate the locking indentations (33) on the Figart mounting bracket (37) rather than on the box (10). Applicant suggests that the Examiner is unable to meet this burden because such a rearrangement would be non-functional with the Figart apparatus. "If proposed modification would render the prior art invention being modified unsatisfactory for its

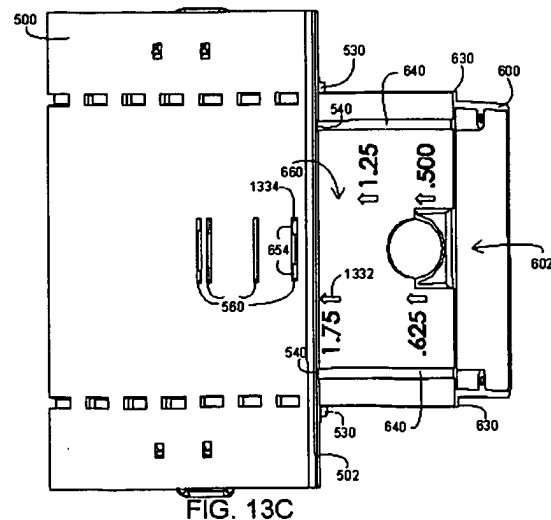
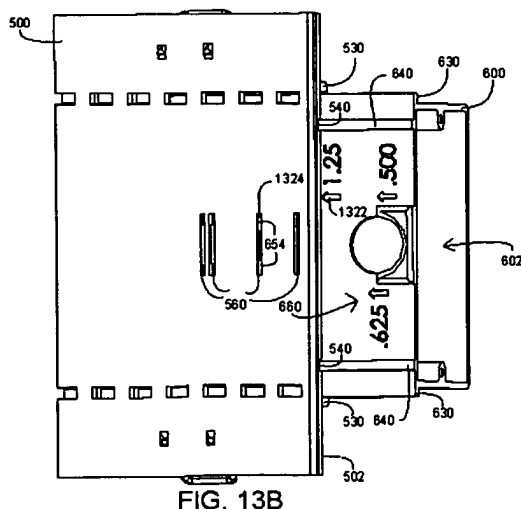
intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01, citing *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

Figart describes the mounting bracket (37) as having a box engaging side plate (40) with a pair of identical locking lugs (33A), which are wedge-shaped extensions, and that these lugs (33A) mate with the indentations 33, as shown in Figart FIG. 6. Figart, c. 5, ll. 8-13. Figart also states that multiple boxes may be fastened together in a side-by-side relationship, as shown in FIG. 3. Figart, c. 5, ll. 3-5. It is apparent, however, in comparing Figart FIGS. 3 and 6 that a rearrangement of the Figart locking lugs (33A) with the indentations (33) would also prevent multiple boxes from being fastened together. Specifically, wedge-shaped locking lugs (33A) extending from the sides of each box (10) would interfere with similar lugs (33A) extending from the sides of an adjacent box (10). It is the very fact that the indentations 33 are located on the boxes that allow multiple Figart boxes (10) to be fastened together.

In summary, the Examiner-suggested rearrangement of the Figart indentations (33) and locking lugs (33A) would not work on the Figart multiple box structure. Thus, Figart cannot be used as motivation for making such a rearrangement on the present invention as claimed in Claim 24. As such, the Office Action has failed to state a prima facie case of obviousness with respect to Claim 24, and, without more, the Applicant is entitled to a grant of Claim 24. *In re Oetiker*, cited above. Claims 25-29, which depend from Claim 24, are also allowable on this basis. Claims 25-29 further patentably distinguish over Figart, as described below.

### Claim 25

FIGS. 10B-C from the present application are reproduced below to illustrate elements of Applicant's claims that patentably distinguish over Figart.



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Claim 25 recites the electrical box assembly of Claim 24 further comprising a plurality of position indicators 660 located on said electrical box 600 associated with said positions (FIG. 13B; FIG. 13C), each of said indicators 660 displaying a corresponding distance from said alignment guide 502 to said front face 602. Claims, p. 46, ll. 7-10.

Without any cited authority, the Examiner apparently rejects Claim 25 outright as printed matter. There is ample case law that such a rejection is improper. In *Flood v. Coe*, 45 USPQ 72 (D.D.C. 1940), the court states:

The invention here is more than an arrangement of printed matter on a piece of paper. There is a definite and decided relationship between the physical structure and the printed matter. The one depends upon the other. In other words, there is a cooperative relationship between the printed indicia and the structural features of the [claimed invention].

*Id.* @ 73, emphasis added. More recently, the Federal Circuit states:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

*In re Gulack*, 217 USPQ 401, 403 (Fed. Cir. 1983), emphasis added.

Here, there is indeed a claimed cooperative relationship between the position indicators and the structural features of the electrical box and box mount. Specifically, the position indicators are associated with the positions of the electrical box. Further, the indicators display a corresponding distance from the alignment guide to the front face.

The Examiner asserts that the cabling labels of Figart FIG. 1 are "similar" to the position indicators of Claim 25. Applicant respectfully disagrees with that assertion. Figart does not disclose or suggest that the cable entry labels shown on Figart FIG. 1 are associated with the positions of the box (10) or that these cable entry labels display a corresponding distance from the leading edge (38) to the box (10) front face. Without such a showing, the Office Action fails to state a prima facie case of obviousness, and, without more, Applicant is entitled to a grant of Claim 25. *In re Oetiker*, cited above. Further, Claim 26, which depends from Claim 25, is also allowable on this basis.

### **Claim 26**

Claim 26 recites the electrical box assembly of Claim 25 wherein said corresponding distance is in the range of 0.5 inches to 1.75 inches. Claims, p. 46, ll. 11-12. Examiner does not address Claim 26 explicitly, other than merely mentioning that Claim 26 was rejected and designating a portion of the Claim 24 elements. As such, the Office Action fails to state a prima facie case of obviousness and, without more, Applicant is also entitled to a grant of Claim 26.

### **Claim 27**

Claim 27 recites the electrical box assembly of Claim 24 wherein said alignment guide is the leading edge 502 of said box mount 500 and each of said position indicators 660 aligns with said leading edge 502 to indicate the current distance between said front face 602 and said leading edge 502. Claims, p. 46, ll. 13-16. The Examiner also does not address Claim 27 explicitly, other than merely mentioning that Claim 27 was rejected and designating a portion of the Claim 24 elements. In view of *Flood* and *In re Gulack* cited with respect to Claim 25, above, in order to reject Claim 27 the Examiner must make a showing that Figart discloses position indicators that align with the leading edge to indicate the current distance between the front face and the leading edge. As such, the Office Action fails to state a prima facie case of obviousness and, without more, Applicant is entitled to a grant of Claim 27. *In re Oetiker*, cited above.

### **Claim 29**

Claim 29 recites the electrical box assembly of Claim 24 wherein said latch portion has a latch release portion configured to accept a tool to pry said latch from a particular one of said catches. Claims, p. 46, ll. 20-22. The Examiner designates a Figart locking lug (33A) as "a latch portion to releasably engage any of said catches." The Figart locking lug (33A) is nothing more than a wedge-shaped extension from the side plate (40). Figart, FIG. 6. The Examiner does not assert that the Figart locking lug (33A) has a latch release portion as claimed, nor does the Examiner designate a particular part relied upon as the latch release portion of the locking lug (33A) as required. *See* MPEP §706(c)(2). Further, the Examiner does not assert that any portion of the Figart locking lug (33A) is configured to accept a tool to pry the Figart locking lug (33A) from a particular one of the Figart indentations (33) as claimed, nor does the Examiner designate a particular part of Figart so configured. *Id.* As such, the Office Action has failed to state a prima facie case of obviousness and, without more, the Applicant is entitled to a grant of Claim 29. *In re Oetiker*, cited above.



## Claim 6 § 103(a) Rejection

### Claim 6

Claim 6, as amended, recites the electrical wiring assembly of Claim 1 wherein said module further comprises a module keyed portion of said back cover, said module keyed portion corresponding to a wiring panel keyed portion, said module keyed portion and said wiring panel keyed portion insuring the proper orientation of said module in said installed position.

To establish a prima facie case of obviousness, the prior art references when combined must teach or suggest all the claim limitations. MPEP §2142. The Examiner asserts that the combination of the Marrero assembly and the keyed module of Figart reads on Claim 6. OA, p. 6, ll. 8-10. Figart, however, teaches that the Figart box (10) is keyed to correspond to the module keying, not the wiring panel. Specifically, Figart does not disclose that the module keyed portion corresponds to a wiring panel keyed portion, as claimed. In particular, Figart states that the ends of the modular receptacle and switch units are dimensioned to slide into the slots (22'), (24') of the box (10). Figart, c. 5, ll. 33-45. Thus, Marrero and Figart combined do not teach or suggested the limitations of Claim 6.

Further, the Examiner has designated the Marrero junction cartridge (22) as a "wiring panel" in rejecting Claim 1, from which Claim 6 depends. Even though there is no suggestion to do so, assume that the Figart box keying was applied to the Marrero junction cartridge (22) in order to create a "wiring panel keyed portion" as claimed. Such a proposed modification would be unsatisfactory for the intended purpose of preventing improper module orientation, demonstrating that there is no suggestion or motivation to make the proposed modification MPEP §2143.01, cited above. As shown in Marrero FIG. 1, only the module prongs (72) contact the junction cartridge (22). Thus, it is not possible for a keyed portion of the Marrero modules, specifically a narrow and a wide end portion as taught in Figart, to contact a corresponding keyed portion of the Marrero junction cartridge (22), i.e. a narrow slot and wide slot, as taught in Figart with respect to an electrical box. Therefore, the Office Action has not stated a prima facie case of obviousness, and, without more, Applicant is entitled to a grant of Claim 6.

## Claims 5 and 11 § 103(a) Rejections

### Claim 5

Claim 5 recites the electrical wiring assembly of Claim 1 wherein said module further comprises an extractor handle, said handle having a closed position secured to said electrical box

and an open position extending away from said module, said handle in said open position claspingsaid module and providing a grip to extract said module from said electrical box.

Claims, p. 41, ll. 6-10.

As stated above, to establish a prima facie case of obviousness, the prior art references when combined must teach or suggest all the claim limitations. MPEP §2142. The Examiner designates the Pham extractor handle (20) as an "extractor handle" according to the claimed invention. The Examiner also designates the Pham processor card (31) as a "module" according to the claimed invention.

The Examiner asserts the combination of the Marrero assembly and the Pham extractor handle (20) renders Claim 5 obvious. OA, p. 7, ll. 18-20. The Pham processor card (31), however, does not comprise the Pham extractor handle (20) as claimed. Rather, the Pham extractor handle (20) is mounted to the processor retention frame (10). Pham, c. 2, ll. 34-36; FIG. 4. Further, the Pham extractor handle (20) does not clasp the processor card (31) in the open position (extending away from the processor card) as claimed. In addition, the function of the Pham extractor handle (20) is only to pry a processor card (31) from its connector. Pham, c. 2, ll. 39-42. The extractor handle (20) does not provide a grip to extract the processor card (31) from the retention frame (10). Thus, Marrero and Pham, when combined, do not teach or suggest all the claim limitations as required. As such, the Office Action fails to state a prima facie case of obviousness.

Further, it is the Examiner's initial burden to provide some suggestion of the desirability of doing what the inventor has done. "The examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §2142, citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Here, the Examiner baldly asserts that the motivation to combine Marrero and Pham is "to better operate the Marrero's assembly." The Applicant respectfully asserts that this is not the convincing line of reasoning required by the case law and the MPEP. Without more, the Applicant is entitled to a grant of Claim 6. *In re Oetiker*, cited above.

#### **Claim 11**

Claim 11 recites the electrical wiring assembly of Claim 7 wherein said module has an extractor handle, said handle having a closed position generally flush with said module and an

open position extended from said module so as to provide a grip, said module securable to said electrical box with said handle in said closed position and removable from said module compartment with said handle in said open position. Claims, p. 42, ll. 21-25.

The same arguments cited with respect to Claim 5, directly above, are equally applicable to Claim 11. In particular, the Pham processor card (31) does not have the Pham extractor handle (20). Thus, the claimed limitation that the module has an extractor handle is not met by the suggested combination of Marrero and Pham. Further, nothing in Pham teaches or suggests that the Pham extractor handle (20) secures the Pham processor card (31) to the Pham processor retention frame (10). As such, the claimed limitation that the module is securable to the electrical box with the handle is also not met. For these reasons and those cited above with respect to Claim 5, the Applicant asserts that the Office Action has failed to state a prima facie case of obviousness with respect to Claim 11. Without more, Applicant is entitled to a grant of Claim 11. *In re Oetiker*, cited above.

In light of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-11, 16-19, 24-29, 32-35 are in condition for allowance. Further, Applicant asserts that added Claims 36-45 patentably distinguish all prior art of record. Thus, pending Claims 1-11, 16-19, 24-29, 32-35 and 36-45 are allowable and Applicant requests that this application be passed to issuance. If, however, the Examiner believes that any issue remains that requires clarification, the Examiner is invited to call the undersigned attorney of record at the number indicated below.

Respectfully submitted,

LAW OFFICE OF GLENN R. SMITH

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By: Glenn R. Smith  
Glenn R. Smith, Esq.  
Registration No. 38,308  
Attorney of Record  
311 Santa Barbara  
Irvine, CA 92606-0807  
Telephone/Fax: (949) 387-1027

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